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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/056,453

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Fred Burbank

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5144

7590

09/14/2006

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EXAMINER

HOEKSTRA, JEFFREY GERBEN

ART UNIT

PAPER NUMBER

3736

DATE MAILED: 09/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/056,453

Applicant(s)

BURBANK ET AL.

Examiner

Jeffrey G. Hoekstra

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 46-63 and 67-75 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 46-63 and 67-75 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Notice of Amendment***

1. In response to the amendment filed on 07/06/2006, amended claim(s) 46, canceled claim(s) 1-45 and 64-66, and new claim(s) 67-75 is/are acknowledged. The current rejections of the claim(s) 46-63 is/are *withdrawn*. The following new and reiterated grounds of rejection are set forth:

### ***Information Disclosure Statement***

2. The information disclosure statement(s) (IDS) submitted on 06/22/2006, 07/17/2006, and 08/28/2006 is/are acknowledged. The submission is in compliance with the provisions of 37 CFR 1.97 and 1.98. Accordingly, the examiner is considering the information disclosure statement(s).

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

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under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 46-50, 52, 57, 58, 67, 70, and 71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Desai (US 5,395,312) in view of Russin (US 5,795,308).

6. Desai discloses a tissue removal system, comprising:

- a biopsy device (20) having a detachable wand (as best seen in Figures 1-3);
- a radially deployable electrosurgical cutting member (202,234) distally disposed about said wand connected to moving elements within the housing for moving the tissue cutting element;
- an electrical connectors (236) connecting an electrical power source to said biopsy device;
- a replaceable drive unit (222) having a receptacle (226) for engaging and holding a portion of the biopsy device;
- a driving element (222) transferring mechanical power from a mechanical power source; and
- a motor unit (214) for engaging and providing power to a drive unit, said motor unit comprising a securing mechanism (220) forming a stable mechanical engagement between said motor and drive element to transfer mechanical power.

7. Desai discloses the claimed invention except for a distally disposed deployable fixation or operative element connected to a biopsy device in a proximal relation to the

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cutting member, wherein said operative fixation element is connected to moving elements within the housing for moving the tissue cutting element. Russin teaches a distally disposed deployable operative fixation element (28) connected to a biopsy device in a proximal relation to the cutting member as best seen in Figures 8 and 9, wherein said operative fixation element is connected to moving elements within the housing for moving the tissue cutting element. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the biopsy system as taught by Desai, with the deployable anchors as taught by Russin for the purpose of increasing patient safety via securing a biopsy device whilst cutting tissue.

8. For claims 47 and 49, Desai discloses a deployable side-cutting mechanism configured to be axially translated about said shaft effective to isolate a body of target tissue when disposed within a patient as best seen in Figure 10.

9. Claims 51, 53-56, 68, 69, and 72-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Desai in view of Russin and in further view of Kresch et al (US 5,527,331).

10. Desai in view of Russin discloses the claimed invention except for (a) a drive elements engaging a shuttle, (b) a drive gear and spindle, and (c) a snap-in securing mechanism and ridged sleeve. Kresch et al teaches a drive element (46) configured to engage a shuttle (48) that is operably connected to said deployment mechanism for deployment or retraction. Kresch et al teaches a drive gear (48) engaging said shaft and wherein said mechanical connector comprises a spindle (125), both of which are for

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transmitting rotary type mechanical power. Kresch et al teaches a motor unit for engaging and providing power to a drive unit comprising a snap-in securing mechanism (45) forming a stable mechanical engagement between said motor and drive unit and coupling mechanism, transmitting rotary mechanical motion, comprising a ridged sleeve (47) adapted to receive a spindle. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the biopsy system as taught by Desai in view of Russin, with the mechanical arrangement as taught by Kresch et al for the purpose of increasing the efficacy of mechanical power transmission via alternative mechanical arrangements.

11. For claim 58, Desai discloses a targeted tissue surgical instrument with an electrosurgical cutting member (266) extending beyond the distal end of the shaft (264).

12. Claims 59-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Desai in view of Russin in further view of Kresch et al and in further view of Gough et al (US 5,683,384).

13. For claims 59-62, Desai in view of Russin in further view of Kresch et al discloses the claimed invention except for the anchoring mechanism formed of electrically conducting metallic wires or ribbons in electrical contact with a proximal electrical power source and comprising a plurality of outwardly extending members configured to penetrate tissue. Gough et al teaches a plurality of conductive wire elongated tissue penetrating antennas (16) (column 6 lines 5-10) in electrical contact with a proximal

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power source (Figure 10). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the biopsy device as taught by Desai in view of Russin in further view of Kresch et al et al, with Gough et al for the purpose of securing tissue ablation antennae into targeted tissue for ablation.

14. For claim 63, Desai in view of Russin in further view of Kresch et al discloses the claimed invention except for the anchoring mechanism mounted movably along said shaft such that radial contraction facilitates advancement of the device and radial expansion facilitates targeted tissue penetration. Gough et al teaches a plurality of tissue penetrating antennas (16) movably mounted along said shaft that contract and expand. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the biopsy device as taught by Desai in view of Russin in further view of Kresch et al, with Gough et al for the purpose aiding in targeted tissue ablation.

### ***Response to Arguments***

15. Applicant's arguments with respect to claims 46-63 and 67-75 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey G. Hoekstra whose telephone number is (571)272-7232. The examiner can normally be reached on Monday through Friday, 8:00 a.m. to 5:00 p.m. EST.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max F. Hindenburg can be reached on (571)272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JH



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